Remarks

This Application has been carefully reviewed in light of the Office Action mailed June 7, 2005. Applicants appreciate the Examiner's consideration of the Application. Although Applicants believe all claims are allowable without amendment, Applicants have made clarifying amendments to Claims 1-3, 6, 8-11, 14, 16-18, 21, 23-27, and 31. At least certain of these amendments are not considered narrowing, and none is considered necessary for patentability. Applicants respectfully request reconsideration and allowance of all pending claims.

I.   The Objections to the Drawings should be Withdrawn

The Examiner objects to the drawings filed on February 26, 2002, as including solid black shading that renders FIGURE 4 unreadable. Applicants have amended FIGURE 4 to remove the solid black shading. Applicants attach to this Response both a Replacement Sheet including these amendments and an Annotated Sheet showing the amendments in red ink. No new matter is added by the amendments to the drawings. Applicants respectfully request approval of the amended drawings and that the Examiner replace sheet 4 of the drawings with the Replacement Sheet, which includes amended FIGURE 4. For at least these reasons, Applicants respectfully request that the Examiner withdraw the objections to the drawings.

II.   Claims 31-41 Recite Patentable Subject Matter

The Examiner rejects Claims 31-41 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully disagree.

The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." *See* 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. *See In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1601-02 (Fed. Cir. 1998). While an abstract idea by

itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. *See AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding 35 U.S.C. § 101 and announced more expansive principles formulated with computer technology in mind); *see also In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

"Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." M.P.E.P. § 2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. *See In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. As stated by the Federal Circuit in *State Street* and as explicitly confirmed in the M.P.E.P., "[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete, and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601-02; M.P.E.P. § 2106. As discussed below, Applicants' Claims 31-41 clearly recite a useful, concrete, and tangible result and are therefore directed to patentable subject matter.

As an example, prior to the amendments presented in the current Response, independent Claim 31 was directed to a "method for altering design of a consumer product in response to consumer preference, wherein consumer preference as to product features is discerned through online survey, comprising" the limitations recited in the body of the claim. Prior to the amendments presented in the current Response, the method was recited as comprising:

- making available to a plurality of consumers an interactive online mock-up for a consumer product having a plurality of product features;
- allowing each of the plurality of consumers to modify at least one of the features to express the customer's design preference;
- gathering data associated with said at least one feature modification; and
- making available to a product designer said gathered data for evaluation.

Thus, even prior to the amendments presented in the current Response, "making available to a product designer said gathered data for evaluation" was one practical application of independent Claim 31, the useful, concrete, and tangible result being the making available to a product designer of the gathered data for evaluation. Therefore, independent Claim 31 and its dependent claims were directed to patentable subject matter even before the amendments made in the current Response.

Additionally, the Examiner cites *Ex parte Bowman*, 61 U.S.P.Q.2d 1669 (Bd. Pat. App. & Inter. 2001) in support of the patentable subject matter rejections. (*See* Office Action, Page 4) Applicants respectfully submit that this decision is irrelevant to the present Application. The patent application under appeal in *Bowman* was held unpatentable as being directed to non-statutory subject matter because the disclosed and claimed invention was directed to nothing more than a human making mental computations and manually plotting the results on a paper chart. *See Bowman*, 61 U.S.P.Q.2d at 1671. The claims of the patent application in *Bowman* included no reference to a computer system or any computer-related function. Indeed the specification of the patent application did not even recite the use of a computer system. *See Id.* These facts were apparently important to the Board, which stated, "Appellant has carefully avoided tying the disclosed and claimed invention to any technological art or environment." *Id.* The Board found that the invention was "nothing more than an abstract idea which is not tied to any technological art, environment, or machine, and is not a useful art as contemplated by the Constitution of the United States. The physical aspects of claim 1, which are disclosed as nothing more than a human manually drawing a chart and plotting points on this chart, do not automatically bring the claimed invention within the technological arts." *Id.*

In contrast to the patent application that was the subject of review in *Bowman*, Applicants' independent Claim 31 specifically recites (both currently and prior to amendments presented in this Response):

- making available to a plurality of consumers *an interactive online mock-up* for a consumer product having a plurality of product features;
- allowing each of the plurality of consumers to modify at least one of the features to express the customer's design preference;
- gathering data associated with said at least one feature modification; and
- making available to a product designer said gathered data for evaluation.

Additionally, Applicants note that the Specification is replete with descriptions of the use of computer systems to perform various steps and functionality recited in Applicants' claims. Thus, the facts in *Bowman* are in no way analogous to the facts in the present case. Applicants respectfully note that the Examiner's statements regarding the alleged shortcomings of the word "online" are not supported by a citation to any statute, regulation, rule, or case.

In any event, although Applicants believe Claims 31-41 are directed to patentable subject matter without amendment for the reasons set forth above, Applicants have amended independent Claims 31 to further clarify that Claim 31 recites a computer-implemented method performed using one or more computer systems and is directed to patentable subject matter. None of these amendments are considered narrowing or necessary for patentability.

For at least these reasons, Applicants respectfully submit that independent Claim 31 and its dependent claims recite patentable subject matter. Thus, Applicants respectfully request that the Examiner withdraw the rejections of Claims 31-41 under 35 U.S.C. § 101.

III. The Claims are Allowable over *Geller*

The Examiner rejects Claims 1-4, 6-12, 14-19, 21-27, and 29-32 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,844,554 to Geller ("*Geller*"). Applicants respectfully disagree.

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in *as complete detail* as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); *see also* M.P.E.P. § 2131. Furthermore, "[t]he elements must be arranged as in the claim under review." *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990); M.P.E.P. § 2131. The distinctions discussed below illustrate that *Geller* fails to disclose, either expressly or inherently, each and every limitation recited in Applicants' claims, as is required under the M.P.E.P. and governing Federal Circuit cases.

With respect to amended independent Claim 1, which Applicants discuss as an example, *Geller* fails to disclose, teach, or suggest at least the following limitations:

- downloading, in response to the customer choosing one or more features, from the server one or more software components relating to each chosen feature; [1]
- allowing the customer to modify at least one of said chosen features of the product by use of the related software component; and
- presenting to the customer for viewing a simulation of the product incorporating said at least one feature modification.

For example, *Geller* fails to disclose, teach, or suggest "downloading, in response to the customer choosing one or more features, from the server one or more software components relating to each chosen feature," as recited in Claim 1 as amended. As allegedly disclosing this limitation, the Examiner cites the following portions of *Geller*: Column 2, Lines 20-36; Column 10, Line 29 through Column 11, Line 11; and Column 14, Lines 30-42.

Column 2, Lines 20-36 of *Geller* merely discloses a product configurator computer program that allows a sales engineering force to create and update a product configurator computer program. (Column 2, Lines 20-23) According to *Geller*, it would be desirable to have a configurator program that is easily customizable for a particular organization and that

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[1] Support for this amendment can be found at least at Page 4, Paragraph 0011; Page 6, Paragraph 0019; Page 8, Paragraph 0023; and Page 11, Paragraph 0031 through Page 12, Paragraph 0033 of Applicants' Specification. Applicants respectfully submit that no new matter is added by this amendment.

is easily updated with new data and constraints on product configurations. Also according to *Geller*, it would be desirable to have the data and constraints stored in a conventional database maintained by the enterprise, and easily read or written into the product configurator. *Geller* discloses that these features would allow the product configurator program to be kept updated easily by sales engineers who are not necessarily expert computer programmers, and utilize a company's existing product database when updating the computers of the sales personnel. While this cited portion of *Geller* appears to disclose customization of a product configurator program, nowhere does this cited portion of *Geller* disclose, teach, or suggest "downloading from the server one or more software components relating to each chosen feature," as recited in Claim 1 prior to the amendments presented in this Response. Even more clearly, this cited portion of *Geller* fails to disclose, teach, or suggest "downloading, in response to the customer choosing one or more features, from the server one or more software components relating to each chosen feature," as recited in Claim 1 as amended.

Column 10, Line 29 through Column 11, Line 11 merely discloses the creation of a GUI by a software developer that may be used with the configuration software. (*See* Column 10, Lines 30-33) Options and controls for those options may be grouped together in the GUI. (*See* Column 10, Lines 39-53) The cited portion further discloses parameters and constraints, most visual controls of the GUI being associated with a parameter and constraints establishing the rules that define the valid relationships between parameters. (*See* Column 10, Line 64 through Column 11, Line 10) While this cited portion of *Geller* appears to disclose the design of a GUI that may be used to configure a product, nowhere does this cited portion of *Geller* disclose, teach, or suggest "downloading from the server one or more software components relating to each chosen feature," as recited in Claim 1 prior to the amendments presented in this Response. Even more clearly, this cited portion of *Geller* fails to disclose, teach, or suggest "downloading, in response to the customer choosing one or more features, from the server one or more software components relating to each chosen feature," as recited in Claim 1 as amended.

Column 14, Lines 30-42 merely discloses using the Borland DELPHI software development environment to construct configuration software user interfaces according to the

invention disclosed in *Geller*. (*See* Column 14, Lines 30-42 and Column 13, Line 66 through Column 14, Line 4) The software developer may use DELPHI to construct custom user interfaces, as well as to construct parameters and constraints that rely on SQL queries from external databases or tables. (*See* Column 14, Lines 38-42) While this cited portion of *Geller* appears to disclose a tool that may be used by a developer to construct configuration software user interfaces, nowhere does this cited portion of *Geller* disclose, teach, or suggest "downloading from the server one or more software components relating to each chosen feature," as recited in Claim 1 prior to the amendments presented in this Response. Even more clearly, this cited portion of *Geller* fails to disclose, teach, or suggest "downloading, in response to the customer choosing one or more features, from the server one or more software components relating to each chosen feature," as recited in Claim 1 as amended.

As another example, at least because *Geller* fails to disclose, teach, or suggest "downloading, in response to the customer choosing one or more features, from the server one or more software components relating to each chosen feature," as recited in Claim 1 as amended, *Geller* necessarily fails to disclose, teach, or suggest "allowing the customer to modify at least one of said chosen features of the product *by use of the related software component [downloaded from the server and relating to each chosen feature]*," as recited in Claim 1.

As another example, *Geller* fails to disclose, teach, or suggest "presenting to the customer for viewing a simulation of the product incorporating said at least one feature modification," as recited in Claim 1. As purportedly disclosing these limitations, the Examiner cites column 10, lines 13-28 of *Geller*. The cited portion of *Geller* merely discloses the need for a software developer (i.e., the person designing the software configuration program) to model a product or service and define the relationships between the product, its options, the availability of material, and other constraints. (Column 10, Lines 13-17) According to *Geller*, a completed executable configurator 10 (e.g., compiled executable configuration software) will help customers and salespeople understand the product, and recognize and choose from the options available. (Column 10, Lines 22-25) The software (e.g., configuration program module 10) will allow experimentation with different configurations, helping to ensure that the final configuration is really what the customer

wants. (Column 10, Lines 26-28) However, nowhere do these cited portions disclose, teach, or suggest "presenting to the customer for viewing *a simulation of the product incorporating said at least one feature modification*," as recited in Claim 1. Indeed the screenshots in the Figures of *Geller* do not show any sort of "simulation of [a] product incorporating . . . at least on feature modification," as recited in Claim 1. (*See, e.g.,* Figures 6-25)

Thus, *Geller* fails to disclose, teach, or suggest each and every limitation recited in Claim 1. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1.

For at least certain analogous reasons, Applicants respectfully submit that *Geller* fails to disclose, teach, or suggest various limitations recited in independent Claims 2-3, 8-11, 16-18, and 23-26, and respectfully request reconsideration and allowance of these independent claims and their dependent claims. Additionally, independent Claims 2-3, 8-11, 16-18, and 23-26 recite further patentable distinctions over *Geller*.

For example, with respect to independent Claim 2, *Geller* fails to disclose, teach, or suggest "allowing the customer to modify at least one attribute of said one or more chosen features by use of the related software component, wherein said at least one attribute relates to one of shape, three-dimensional location and appearance." Independent Claims 9-11, 17, and 24-26 recite certain substantially analogous (although not necessarily identical) limitations. The portions of *Geller* cited by the Examiner fail to disclose, teach, or suggest these limitations. For example, the Examiner apparently references Figures 6 and 7 of *Geller* as allegedly disclosing these limitations. (*See* Office Action, Page 6) However, nowhere do Figures 6 and 7 disclose, teach, or suggest "allowing the customer to modify at least one attribute of said one or more chosen features by use of the related software component, wherein said at least one attribute relates to one of shape, three-dimensional location and appearance," as recited in Claim 2. As another example, the Examiner apparently cites Column 17, Lines 10-29 of *Geller* as allegedly disclosing these limitations. (*See* Office Action, Page 6) However, this cited portion of *Geller* also fails to disclose, teach, or suggest "allowing the customer to modify at least one attribute of said one or more chosen features by

use of the related software component, wherein said at least one attribute relates to one of shape, three-dimensional location and appearance," as recited in Claim 2.

As another example, with respect to independent Claim 10, *Geller* fails to disclose, teach, or suggest "viewing a simulation of the product incorporating said at least one feature modification, wherein said simulation is available to the server for evaluation." Independent Claim 10 recites certain substantially analogous (although not necessarily identical) limitations. The Examiner apparently cites column 10, lines 13-28 as allegedly disclosing these limitations. (*See* Office Action, Page 6) However, nowhere does the cited portion of *Geller* disclose, teach, or suggest, at a minimum, "wherein said simulation is available to the server for evaluation," as recited in Claim 10.

With respect to independent Claim 31, at a minimum, *Geller* fails to disclose, teach, or suggest "making available to a product designer said gathered data for evaluation." In rejecting Claim 31 based on *Geller*, Applicants respectfully submit that the Examiner did not identify any portion of *Geller* as allegedly disclosing this limitation. (*See* Office Action, Pages 5-6) Applicants respectfully submit that *Geller* does not appear to disclose, teach, or suggest this limitation. Applicants reiterate that "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131.

For at least these additional reasons, Applicants respectfully request reconsideration and allowance of independent Claims 2-3, 8-11, 16-18, 23-26, and 31 and their dependent claims.

IV.   The Claims are Allowable over the Proposed *Geller-Abelow* Combination

The Examiner rejects Claims 5, 13, 20, 28, and 33-41 under 35 U.S.C. §103(a) as being unpatentable over *Geller* in view of U.S. Patent No. 5,999,908 to Abelow ("*Abelow*").

Claims 5, 13, 20, 28, and 33-41 depend from independent Claims 3, 11, 18, 26, and 31, respectively, which Applicants have shown above to be clearly allowable, and are

allowable for at least this reason. In addition, dependent Claims 5, 13, 20, 28, and 33-41 recite further patentable distinctions over the Examiner's proposed *Geller-Abelow* combination. To avoid burdening the record and in view of the clear allowability of independent Claims 3, 11, 18, 26, and 31, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicants do not admit that the proposed combination of *Geller* and *Abelow* is possible or that the Examiner has demonstrated the requisite teaching, suggestion, or motivation to combine these references.

For at least these reasons, Applicants respectfully requests reconsideration and allowance of dependent Claims 5, 13, 20, 28, and 33-41.

V. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.
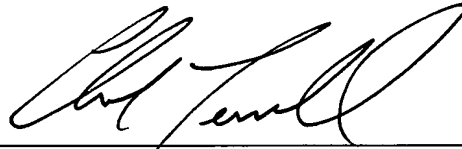
Conclusion

Applicants have made an earnest attempt to place the Application in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any way, the Examiner is invited to contact the undersigned Attorney for Applicants at the Examiner's convenience at (214) 953-6813.

Although Applicants believe no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,
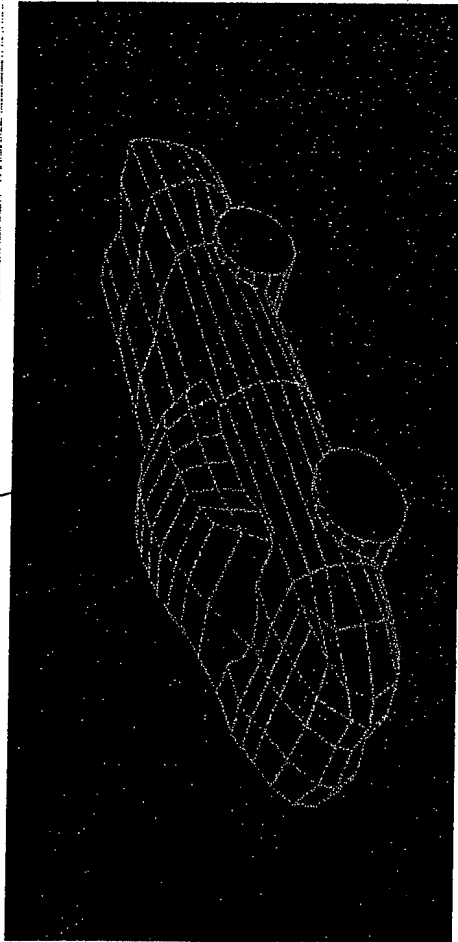
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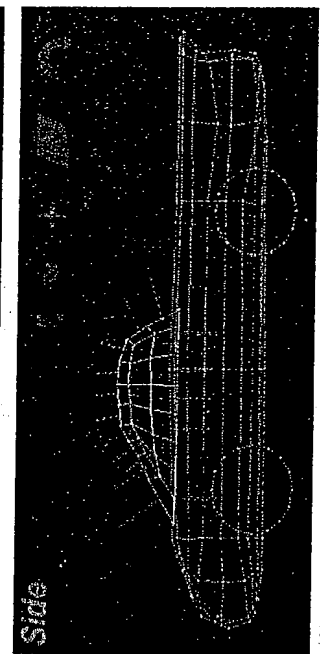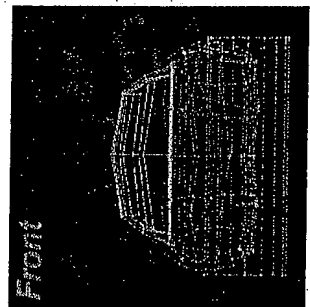
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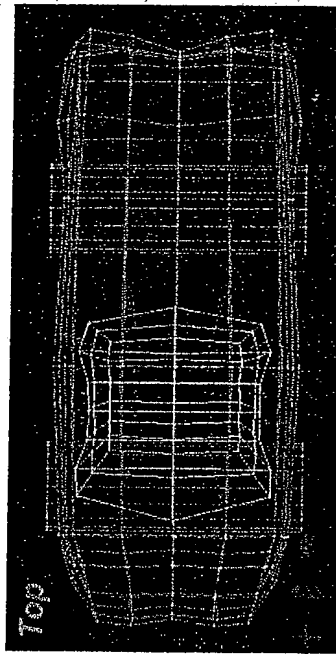
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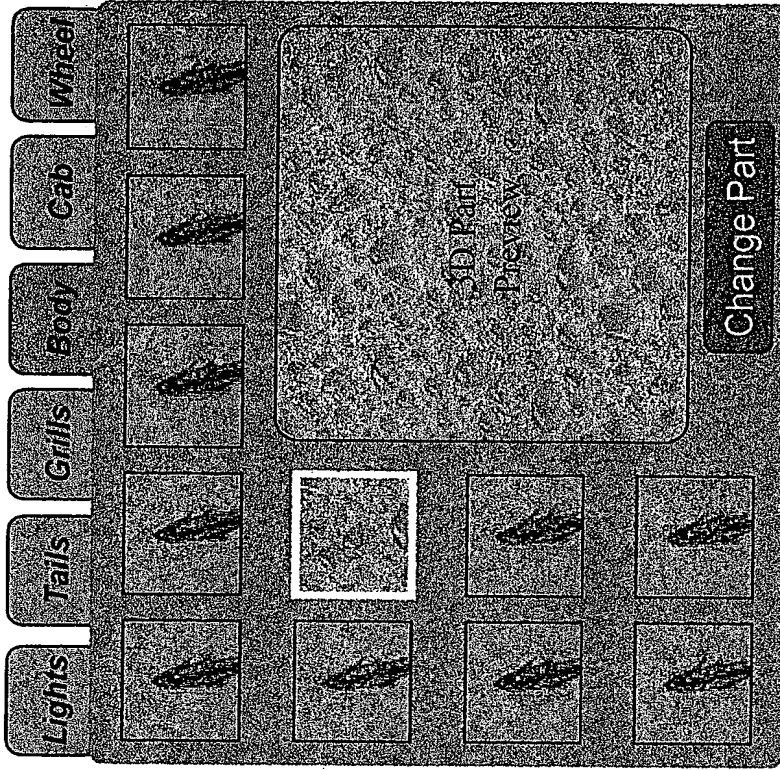Attorney's Docket: 014208.1434 (79-01-002)
For: M/A for Interactive Online Modelling and
Evaluation of a Product
By: Coke II, et al.
USSN 10/010,289 filed 10/22/01

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ANNOTATED SHEET

Remove Shading

FIG. 4